

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1612

In re Patent Application of

ARNAUD et al

Serial No. 09/049,927

Filed: March 30, 1998

Title: ANHYDROUS COSMETIC OR DERMATOLOGICAL COMPOSITION....

Assistant Commissioner for Patents
Washington, DC 20231

Sir:



Atty Dkt. 2350-60
C# M#
Group Art Unit: 1612
Examiner: Huang
Date: April 28, 2000

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MAY 04 2000

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Fees are attached as calculated below:

Total effective claims after amendment	0	minus highest number		
previously paid for	0	(at least 20) =	0 x \$ 18.00	\$ 0.00
Independent claims after amendment	0	minus highest number		
previously paid for	0	(at least 3) =	0 x \$ 78.00	\$ 0.00
If proper multiple dependent claims now added for first time, add \$260.00 (ignore improper)				\$ 0.00
Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$380.00/2 months; \$870.00/3 months)				\$ 0.00
Terminal disclaimer enclosed, add \$ 110.00				\$ 0.00
First submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$690.00)				\$ 0.00
Second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$690.00)				\$ 0.00

☐ Please enter the previously unentered , filed

Subtotal \$ 0.00

If "small entity," then enter half (1/2) of subtotal and subtract

-\$ 0.00

☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$240.00)

\$ 0.00

Assignment Recording Fee (\$40.00)

\$ 0.00

Other:

0.00

TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.
By Atty: B.J. Sadoff, Reg. No. 36,663

Signature: _____

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In re PATENT APPLICATION OF
ARNAUD et al.



Atty. Ref.: 2350-60

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Assistant Commissioner of Patents
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TECH CENTER 1600/2900

RESPONSE

Sir:

Responsive to the Office Action dated January 28, 2000, consideration of the following and attached is requested.

Claims 13-37 are pending.

The claims are directed to a "solid silicone composition" which contains a "polyethylene solidifying agent". The Examiner has agreed the specification teaches "solid" silicone compositions. The only remaining issue is whether the application "supports" the claimed polyethylene "solidifying agent" as allegedly required under Section 112, first paragraph. That is, the Examiner has maintained the Section 112, first paragraph rejection of claims 13-37 based on an alleged failure of the specification to "support" the recited polyethylene "solidifying agent". The rejection is traversed and reconsideration and withdrawal of the rejection are requested in view of the following and attached.

The applicants note that page 1, lines 13-16 (i.e., the third full paragraph) describes the production of solid, silicone-containing compositions wherein a wax is used. One of ordinary skill would appreciate from the whole of the specification that the wax is used as a "solidifying agent". Moreover, the application clearly describes that the preferred wax is the recited polyethylene. See, page 5, lines 5-8, of the specification.

Finally, examples 4 and 5 of the specification (pages 14-15) describe solid compositions (i.e., lipsticks) wherein one of ordinary skill would appreciate that the 20% polyethylene is being used as a solidifying agent.

Beyond these teachings of the present specification, the applicants submit the evidence of record clearly supports that the recited polyethylene inherently function as a solidifying agent. The Examiner is urged to appreciate that the Court of Customs and Patent Appeal (CCPA) has held that an inherent disclosure of a property or structure may be demonstrated by an Affidavit, from another, which reports on results developed after the filing date. See, In re Magerlein, 145 USPQ 683 (CCPA 1965) (copy attached).

One issue presented in Magerlein was whether the original disclosure adequately identified the claimed 16 α -hydroxy form of the recited steroid. On this point the Court found that there was no reason to doubt that one skilled in the art following the teaching of the application would be able to produce the claimed compounds and identify them as 16 α -hydroxy steroids.

In the present case, there similarly appears to be no question as to whether one of ordinary skill in the art following the teaching of the application would have been able to produce the claimed compositions and identify them as solids.

The other issue considered by the Magerlein court was

"whether there was sufficient evidence in the record to show the α orientation to be an inherent characteristic of the subject matter to be identified." See, 145 USPQ 685.

Magerlein had amended his specification during prosecution to recite the specific 16 α -hydroxy form of the steroid in response to a rejection for insufficient disclosure.¹ The Examiner then rejected the claims as containing new matter. In response, the appellants submitted an affidavit comparing the chemical characteristics (melting point and infra-red analysis) of a compound prepared according to the method of their application and a compound prepared by a subsequently published method of another (i.e., Bernstein) which was known to produce a 16 α hydroxy form of the steroid.

While the court refused to consider the sufficiency of the data presented, because the issue was not considered by the Board, the court made reference to its earlier decision in In re Nathan, 140 USPQ 601 (CCPA 1964) (copy attached) in noting that an applicant could rely on later-developed results from another to support a claim recitation inherently disclosed in the original specification.

Specifically, the appellant in Nathan claimed 2-halo steroids where the original disclosure did not specify the substitution at the 2 position of the steroid. Like the Magerlein court, the Nathan court found the issue to be

"... where appellants' identification of their 2-halo steroids in their original disclosure is adequate to identify the claimed subject matter and whether there is sufficient evidence in the record to show the alpha orientation to be an inherent

¹ In the present case, the applicants have not amended their specification to include a recitation of the polyethylene as a "solidifying agent", however, the applicants request an opportunity to do so if the Examiner believes it necessary.

characteristic of the subject matter so identified. If the answers are in the affirmative then appellants' amendment specifying the alpha orientation for the 2-halo substituent is not new matter but rather is merely a statement of an inherent property of the steroids as disclosed in appellants' original disclosure." 140 USPQ 603.

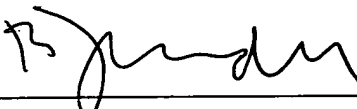
The appellants in Nathan convincingly demonstrated, by comparison with subsequently published results of another, that a process disclosed in their application necessarily produced the claimed product.

In the present application, the extensive evidence which has already been submitted and considered by the Examiner from, for example, the Stepniewski patent file history, clearly establishes that the recited polyethylene inherently functions as a solidifying agent. This evidence, as well as the whole of the disclosure of the above-identified application, provide sufficient "support" for the presently claimed invention.

Withdrawal of the Section 112, first paragraph, rejection of claims 13-37 in view of the above, attached and evidence of record, is requested along with an indication that the claims are allowable. The Examiner is invited to contact the undersigned if anything further is required.

Respectfully submitted,

NIXON & VANDERHYE, P.C.

By: 
B.J. Sadoff
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Attachment
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